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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,794	02/23/2004	Mark Roland Boeder	28967.0178	6789
27890 7590 10/22/2009 STEP TOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				
EXAMINER				
HWU, JUNE				
ART UNIT		PAPER NUMBER		
1661				
MAIL DATE		DELIVERY MODE		
10/22/2009		PAPER		

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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK ROLAND BOEDER

Appeal 2009-003289
Application No. 10/782,794
Technology Center 3600

Oral Hearing Held: September 22, 2009

Before TONI R.SCHEINER, ERIC GRIMES and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Tuesday, September 22, 2009, commencing at 1:22p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown, Notary Public.

PROCEEDINGS

THE USHER: Calendar Number 75, Mr. Parkhurst.

JUDGE SCHEINER: Thank you.

THE USHER: You're welcome.

JUDGE SCHEINER: Good afternoon.

MR. PARKHURST: Good afternoon.

JUDGE SCHEINER: Would you like to introduce your colleague for the record?

MR. PARKHURST: Yes, Your Honor. I'm accompanied today by Mrs. Houda Morad, M-O-R-A-D, who is an attorney at law, a registered patent attorney and an associate of our firm.

JUDGE SCHEINER: Thank you. You may start whenever you're ready.

MR. PARKHURST: Thank you. May it please the Board, I'm Roger W. Parkhurst attorney for the Appellant. And this is an appeal of a plant patent application. The sole claim in this Application reads a new and distinct variety of chrysanthemum plant as described and illustrated, and the particular plant is named Cetwotone Pink.

Appellants appeal the rejection under Section 102 of that claim based upon Appellant's own European Plant Breeder's Right Application, so-called PBR Application, published February 15, 2002, taken in view of the admitted fact that the claimed plant was first sold outside the United States in the Netherlands in August of 2002, further in view of the teaching of the Royal Horticultural Society Dictionary of Gardening to the effect that it describes how to reproduce the chrysanthemum.

1 The PTO admits that the published PBR Application itself is not
2 enabling. It theorizes that the admitted sale, albeit outside the United States,
3 put the public in possession of the claimed plant more than one year before
4 Appellant's filing date.

5 Now, I'll be happy to discuss with the panel any issue in the case that
6 you'd like to talk about, but I plan to really address only two. One is that a
7 clear and objective understanding of the law as stated in the LeGrice,
8 Thomson and Elsner cases is that those decisions did not and could not have
9 ignored the language of Section 102(b) of the statute.

10 And second, that the evidence in this record does not demonstrate that
11 one of ordinary skill in the art or the public, and in particularly the American
12 public, was in possession of Appellant's invention more than a year before
13 Appellant's filing dates.

14 I'll first compare the rejection as stated to the law that is discussed
15 throughout this record. And Appellant advocates that the Board adopt an
16 objective and logical understanding of the lawful meaning of both the dicta
17 and the conclusions stated in those cases that I mentioned a moment ago.

18 In 1962 with the CCPA in LeGrice reversed a PTO rejection under
19 Section 102(b) based upon foreign applications because those publications
20 were not themselves enabling. In LeGrice, the Court repeatedly emphasized
21 the need for the prior art to put the skilled artisan in possession of the
22 claimed invention.

23 And the LeGrice court said that in order for a publication to be an
24 effective Section 102(b) bar, its description must be capable when taken in

1 conjunction with the knowledge of those skilled in the art of placing the
2 invention in possession of those so skilled.

3 In 1992 in Thomson, an earlier panel of this Board said the same
4 thing. But they then went on to add that the issue is not whether the cultivar
5 was in public use or sale in the United States, sort of reflecting back to
6 Section 102(b), the language of 102(b), but rather whether seeds were
7 available to a skilled artisan anywhere in the world such that he or she could
8 attain them and make or reproduce the cultivar disclosed in the cited
9 publications.

10 Now, I presume that the word "attain" is a typo for the word "obtain,"
11 which makes more sense in that sentence.

12 The Board in that case presumed that -- based on the evidence in the
13 record and the lack of contrary evidence, the Board presumed that skilled
14 artisans throughout the world would have found seeds readily available on
15 the open market.

16 I can only presume that that statement means that even if seeds were
17 not actually on sale within the United States by a seller in the United States,
18 that the seeds were so notoriously available outside of the United States that
19 they were available for sale into the United States. The record in that case is
20 unclear on such points.

21 By the way, I'm talking about these three cases -- LeGrice, Thomson
22 and Elsner -- because they are the three cases that all involved plant --
23 Thomson was a utility patent but the subject matter was still plants -- but all
24 three of them involved plants and they involved foreign-based prior art.

1 Moving on to Elsner in 2004. In Elsner, the Federal Circuit said that
2 the focus of the analysis is not whether the foreign sales are themselves
3 Section 102(b) prior art. I'm going to stop there for a minute. Why would
4 the Federal Circuit have said that? We believe that they said that because
5 they knew that a foreign sale, the act of a foreign sale, a foreign seller in a
6 foreign country offering and selling to a foreign buyer also in a foreign
7 country did not qualify as a Section 102(b) bar because of the language in
8 the statute.

9 So they were not saying that Section 102(b) does not have some role
10 in these cases; they were saying that the focus, and I now continue with the
11 quote, is whether the publication has placed the claimed invention in the
12 possession of the public before the critical date. The critical date, of course,
13 is one year before an Applicant's U.S. filing date.

14 The Court went on to say, thus, foreign sales of the claimed plants
15 may, and I emphasize to you the word "may," the permissive word "may." It
16 is not mandatory language; it is permissive language. May be within the
17 knowledge of the skilled artisan and may be considered to provide the public
18 with access to Appellant's invention. Again, emphasize the permissive
19 language in Elsner.

20 JUDGE GRIMES: But didn't the Court go on to provide the
21 conditions that define whether the foreign sale was sufficiently accessible to
22 members of the public and whether people skilled in the art would be able to
23 take that material and asexually reproduce the claimed plant as the
24 conditions under which a foreign sale can be enabling when a foreign
25 publication does not by itself enable?

1 MR. PARKHURST: I'm not sure what we mean by the word
2 "define." But certainly they discuss that in a plant patent case you need to
3 have possession of the plant genetic material in order to be able to reproduce
4 it.

5 Now, the issue, the corresponding point you mentioned in this case is
6 would one of ordinary skill in the art in possession of that material know
7 what to do with it to reproduce it? And that is not an issue here.

8 We agree that, for example, the disclosure of the dictionary cited in
9 conjunction with this rejection would show one skilled in the art would
10 know how to reproduce a chrysanthemum.

11 But I think the key point that the Court in *Elsner* was pointing was
12 saying that you've got to investigate seriously the facts of the accessibility of
13 the product that was sold abroad. Does that product -- did that product
14 eventually become in the possession of one of ordinary skill in the art at a
15 time and place such that it fit within the rubric of prior art?

16 JUDGE GRIMES: Well, is that really what they remanded to the
17 USPTO to determine?

18 MR. PARKHURST: Excuse me? I'm sorry.

19 JUDGE GRIME: The remand to the Patent Office was to determine
20 issues of accessibility of the foreign sales.

21 MR. PARKHURST: Right.

22 JUDGE GRIMES: But the standard that the Court set out was that the
23 foreign sale must not be an obscure solitary occurrence that would go
24 unnoticed by those skilled in the art. It doesn't talk about actual possession

1 of any particular -- any actual person skilled in the art or possession in any
2 particular place.

3 MR. PARKHURST: Well, I agree that they pointed to looking for the
4 lack of obscurity. Certainly they did say that. I think what is more
5 important is what they did not say. They did not say that the other elements
6 of Section 102 may play a role in what the meaning of the phrase "one of
7 ordinary skill in the art" is and what the meaning of the phrase "prior art" is.
8 And I don't believe that they could have, and I don't believe they had the
9 authority to read the time and geographic limitations out of Section 102.

10 JUDGE FREDMAN: I don't really need to read the geographic
11 limitations out. This is a foreign publication, not a foreign sale. So the
12 publication there is no doubt existed and it existed in a -- more than a year
13 prior. So the only question is, was that publication enabled, which is a
14 separate question from whether it existed?

15 MR. PARKHURST: Well, you've used the phrase, "Is the foreign
16 publication enabled?" And that is certainly a phrase that comes out of the
17 cases. I quibble with that a little bit because the logic of the matter is we're
18 talking about, does the foreign publication enable one of ordinary skill in the
19 art to make and use the invention? And to simply say we're looking at the
20 metes and bounds of this foreign publication doesn't really fully answer that
21 question.

22 I believe that what the Court was saying in *Elsner* is that we recognize
23 that in plant patents, the publication, the foreign publication cannot be
24 enabling because one of ordinary skill in the art has to have the material to
25 reproduce the plant.

1 So then how would the one of ordinary skill in the art be enabled in
2 view of this foreign publication? They say, well, we also recognize the acts
3 of foreign sales alone are not Section 102(b) barring acts, but we urge you to
4 look at what happened to the products of those foreign sales.

5 Did those -- the products of those foreign sales become accessible at
6 times and places so that they fell within the scope of the knowledge of one
7 of ordinary skill in the art as that term is understood in U.S. law?

8 JUDGE GRIMES: But what place would they have to be in order to
9 be accessible to one of ordinary skill in the art? It is not an American of
10 ordinary skill in the art, is it?

11 MR. PARKHURST: In our view, it would have to be in the United
12 States because Section 102(b) requires that there be use in the United States.

13 JUDGE GRIMES: Well, that is one of the provisions of Section 102.
14 But there is also the printed publication which is a separate category of
15 102(b) prior art. And my understanding of Elsner is that is the category that
16 was at issue.

17 You have a printed publication, which was the PBR, and the foreign
18 sale was evidenced that that PBR was enabling because you could obtain the
19 plant through the foreign sale.

20 MR. PARKHURST: Well, the foreign sale was only evidence that the
21 plant material had been sold abroad, and I don't believe Elsner says that the
22 act of the sale was the thing that enabled the PBR.

23 I believe that Elsner said and returned the case to the PTO to look at
24 the evidence to see whether or not the products of that sale were accessible
25 in a way that they would fit into the normal rubric of prior art.

1 JUDGE GRIMES: How do you square that with the Court's statement
2 that whether or not the foreign sale was prior art is not an issue?

3 MR. PARKHURST: They say -- that is the very thing that I quoted.
4 They say the focus of the analysis is not whether the foreign sales are
5 themselves 102(b) prior art. And the point, of course, is, as I think I said
6 before, if you have a foreign seller located outside the United States offering
7 to and making a sale to a foreign buyer, all of these things and people being
8 outside the United States, those acts do not fall within Section 102(b).

9 JUDGE FREDMAN: Right. The Court is recognizing that and that
10 is why they're asking the question of whether it falls under 102(b) under the
11 printed publication requirement, right?

12 MR. PARKHURST: And they've already admitted that it does not
13 because the printed publication, per se, is not enabling.

14 JUDGE FREDMAN: Okay.

15 MR. PARKHURST: I'm glad that you asked these questions because
16 I think they go right to the heart of understanding where the law really is
17 after Elsner, and I think a lot of people in our field have a little bit of a
18 wrong impression of that.

19 JUDGE GRIMES: As I understand it, your position is that the foreign
20 sale has to enable possession in the United States of the claimed plant prior
21 to the critical date.

22 MR. PARKHURST: Yes.

23 JUDGE GRIMES: Is that accurate?

24 MR. PARKHURST: Yes.

25 JUDGE GRIMES: And what in Elsner do you base that on?

1 MR. PARKHURST: Well, we believe that Elsner doesn't really say
2 that that is not the case; we believe that the definition of prior art and the
3 definitions of one of ordinary skill in the art are essentially coextensive in
4 content and that to have an enabling disclosure that enables one of ordinary
5 skill in the art, you have to have prior art that does that.

6 And the prior art -- and the prior art has to come in in some way under
7 section 102(b).

8 JUDGE GRIMES: Can you identify any other cases where there has
9 been a holding that prior art was not sufficiently accessible because it wasn't
10 accessible to Americans, that the accessibility to foreign people of ordinary
11 skill in the art would not suffice?

12 MR. PARKHURST: No, I can't -- I cannot, nor can I identify a case
13 that goes the other way on that precise point unless you want to talk about
14 Thomson, which we've already talked about.

15 JUDGE GRIMES: Okay. Thank you.

16 MR. PARKHURST: Okay. So we're essentially saying when you get
17 done really boring into what was said in that series of cases, that the ultimate
18 issue in the possibility of having a Section 102(b) rejection or bar is highly
19 dependent upon the facts concerning whether or not -- whether or not the
20 key material here, plant material, was indeed accessible to one of ordinary
21 skill in the art as that term is meant -- has meaning in our law.

22 I think we've made in our discussions several of the points that I had
23 prepared, and I won't go over them again except to urge you, again, to look
24 at the cases in quotations at page 7 of our Reply Brief on the definitions of
25 prior art and one of ordinary skill in the art.

1 And I also note that in the quotation from the Kimberly-Clark case
2 there, there is reference to "at a given time." And "at a given time," of
3 course, under 102(b) means more than one year before the U.S. filing date.
4 So it is our position that 102(b) still has a role in this analysis.

5 Now, turning now to the evidence in this record. It is our view that
6 the evidence that is in this record does not prove that there was or could have
7 been possession of the necessary plant material in the United States or to one
8 of ordinary skill in the art as those terms -- as that term is used in U.S. law
9 more than a year before the U.S. filing date of this application.

10 As pointed out in the rejection itself, it is an admitted fact in this
11 record that the first sale of the subject matter that is claimed in the case took
12 place in the Netherlands sometime in August of 2002.

13 It is also pointed out in the record that under U.S. law, there is a
14 six-month quarantine period provided by 7 CFR Section 319.37 for such
15 plant materials imported into the United States.

16 JUDGE GRIMES: Does that apply to cut flowers?

17 MR. PARKHURST: Yes, I believe so.

18 JUDGE GRIMES: There wouldn't be much point of importing cut
19 flowers if they were quarantined for six months, would there?

20 MR. PARKHURST: I accept your point.

21 JUDGE FREDMAN: And there is none. For cut flowers, I know
22 there is no such quarantine. I have relatives in the flower business.

23 MR. PARKHURST: Okay. I'm not aware of it. I understand the
24 logic that both of you have indicated.

1 So if the six-month quarantine does apply, then that would mean that
2 there had to be -- that the sale had to occur before at least August 23rd of
3 2002. The record is unclear as to when the sale actually occurred, but there
4 is no further indication of when any other sale occurred more than six
5 months before the one-year bar date before the U.S. filing date.

6 JUDGE FREDMAN: One other question about this because I think it
7 is an interesting point you're raising. And I wonder, we're talking about
8 possession, right? So if I purchased the product and, therefore, I have
9 ownership of the product. It has been transported to the United States and
10 presumably it is sitting in a laboratory at APHIS or wherever they store
11 these. Am I in possession of it at that point or not?

12 MR. PARKHURST: I think so. If something like the quarantine does
13 not apply so that you're --

14 JUDGE FREDMAN: Let's assume the quarantine applies in this case.
15 That is the question. Under your scenario, I'm having a quarantine -- in
16 other words, I own the item but simply it is not in my physical possession; it
17 is located wherever the government stores these quarantine items. They
18 must store them somewhere.

19 MR. PARKHURST: It is not accessible for you to try to reproduce
20 that plant material until that quarantine is over and you can take it out of
21 quarantine. That is our view.

22 JUDGE FREDMAN: Okay.

23 MR. PARKHURST: So just getting back to -- if the six-month
24 quarantine applies, you've got these -- let's say hypothetically the first sale
25 was on August 1st, you've got 23 days there, and we don't know whether the

1 sale occurred on the 1st or the 23rd or in between. And there would be a lot
2 of other unanswered questions like, who was it sold to? When were the
3 goods delivered? What kind of arrangements did the buyer make to ship the
4 goods to the United States? How long did that take? When did quarantine
5 start? There is a whole series of other questions that are unanswered.

6 JUDGE SCHEINER: Wouldn't Appellants be in the best position to
7 answer those questions, though, as opposed to the Examiner?

8 MR. PARKHURST: Maybe. But it is my present understanding that
9 the client answered the questions that it knew the answers to.

10 JUDGE FREDMAN: So we have a period that is greater than six
11 months by a little bit, 23 days, is that what you're saying, potentially?

12 MR. PARKHURST: Possibly.

13 JUDGE FREDMAN: Because we just had a Federal Circuit decision
14 come out, I think, today or yesterday about availability of a reference where
15 there was no need -- I mean, it is sort of a standard thing, but there was no
16 need to show that anyone had actually done it, right?

17 In other words, the reference was available -- I mean, they remanded,
18 actually, because there was no such Dialog that it was actually available as
19 of the date, which is kind of a little interesting for this case.

20 But there was no need to show that somebody had actually accessed
21 it. And that is pretty standard. They were simply showing that it was
22 capable of being accessed, which is sort of a standard rule. Here, it could
23 have been capable of being bought whether someone did or not. Would that
24 not suffice?

25 MR. PARKHURST: Well, capable of being bought abroad?

1 JUDGE FREDMAN: Assuming it was sold August 1st, which I guess
2 I don't know, and someone had bought -- a U.S. person had bought it,
3 imported by FedEx that day, it could have been capable of having passed
4 through the quarantine, presumably, if I'm understanding correctly, more
5 than one year prior?

6 MR. PARKHURST: Yes.

7 JUDGE FREDMAN: Okay.

8 MR. PARKHURST: Yes. Of course, we're assuming --

9 JUDGE FREDMAN: I understand it is entirely hypothetical.

10 MR. PARKHURST: Right. Okay. I think that we've discussed the
11 points that I wanted to make with you, and so I will not argue further except
12 to urge you to think carefully, objectively, logically about what the state of
13 the law is and what the facts do -- on this record do and do not show. Thank
14 you very much.

15 JUDGE SCHEINER: Thank you for coming in.

16 (Whereupon, the proceedings at 1:47 p.m. were concluded.)
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